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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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David M. Lockman

Name of person mailing Document or Fee

Signature

August 27, 2007

Date of Signature

Re: Application of: White
 Serial No.: 09/678,885
 Filed: October 3, 2000
 For: Selective Omission Of Transaction Data
 In A Digital Receipt
 Group Art Unit: 3627
 Confirmation No.: 4770
 Examiner: Andrew J. Rudy
 MMB Docket No.: 1001-0700

TRANSMITTAL OF APPEAL BRIEF

Please find for filing in connection with the above patent application the following:

- 1). Appeal Brief with appendices (14 pages);
- 2). A check in the amount of \$500.00; and
- 3). One (1) return Postcard.

The fee for filing an appeal brief as required by 37 C.F.R. § 41.20(b)(2) is paid by the enclosed check. Please charge any other fee deficiency or credit any overpayment to Deposit Account No. 13-0014.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "David M. Lockman", written in a cursive style.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MMB Docket No. **1001-0700**

NCR Docket No.: **9236**

Application of: **Daniel F. White**

Group Art Unit: **3627**

Serial No.: **09/678,885**

Examiner: **Andrew J. Rudy**

Filed: **October 3, 2000**

Confirmation No.: **4770**

For: **Selective Omission of Transaction Data in a Digital Receipt**

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BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks

Alexandria, VA 20231

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of the claims 1, 4-6, 9 and 10 of the above-identified patent application. These claims were indicated as finally rejected in an Office Action dated April 7, 2007. This brief is being filed together with the \$500.00 fee required under 37 CFR § 41.20(b)(2). Also, please provide any extension of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

NCR Corporation of Dayton, Ohio is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this patent application (serial no. 09/678,885).

(3) STATUS OF CLAIMS

Claims 1, 4-6, 9-11, 14-16, and 19-20 are pending in the application.

Claims 11, 14-16, 19-20 have been withdrawn from consideration.

Claims 2-3, 7-8, 12-13, and 17-18 have been canceled.

Claims 1, 4-6, and 9-10 are finally rejected, and are being appealed.

A listing of all claims and their status is shown in the Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellant has filed no amendments subsequent to the Final Office Action mailed April 30, 2007.

(5) SUMMARY OF INVENTION

Appellants' invention is a retail terminal that enables a consumer to use a retail terminal to remove data from a digital receipt and send the modified receipt to a device associated with the person who identified the data for removal (Applicant's specification, page 25, lines 12-20; page 36, line 22 to page 37, line 21; FIG. 1; and FIG. 10). This selective modification of a digital receipt enables a consumer to address privacy concerns. The modified digital receipt that is transmitted to a consumer's device is not the same digital

receipt that is transmitted to a central office for processing of the transaction (Applicant's specification, page 37, lines 15-18).

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether U.S. Patent Number 7,158,948 to Rodriguez teaches or suggests the limitations in claims 1, 4-6, and 9-10 that input data are received at a retail terminal to identify data to be omitted from a digital receipt that was generated by the retail terminal and that the digital receipt from which the data are omitted is forwarded over a network by the retail terminal to a device associated with the person who input the data at the terminal while the unmodified digital receipt is stored by the terminal in a merchant location.

(7) ARGUMENT

Whether U.S. Patent Number 7,158,948 to Rodriguez teaches or suggests the limitations in claims 1, 4-6, and 9-10 that input data are received at a retail terminal to identify data to be omitted from a digital receipt that was generated by the retail terminal and that the digital receipt from which the data are omitted is forwarded over a network by the retail terminal to a device associated with the person who input the data at the terminal while the unmodified digital receipt is stored by the terminal in a merchant location.

The Examiner has failed to make out a prima facie case of obviousness with respect to claims 1, 4-6, and 9-10. In general, the Examiner's rejection is unsupported by Rodriguez because it does not disclose or suggest the limitations that a retail terminal receives input from a person at the retail terminal to identify purchase transaction datum to be omitted from a digital receipt generated with the retail terminal and that the digital receipt from which the data are omitted is forwarded over a network by the retail terminal to a device associated with the person who input the data at the terminal while the unmodified digital receipt is stored by the terminal in a merchant location. These or similar limitations are present in all of the rejected claims being appealed.

All of the claims argued with respect to this ground of rejection relate to a method for generating a digital receipt with a retail terminal from purchase transaction data *and* for

receiving from a person at the terminal input that identifies data to be omitted from the digital receipt. The digital receipt from which the selected data are omitted is denoted a personalized digital receipt in the claims. The personalized digital receipt is sent over a network coupled to the retail terminal to a device associated with the person who provided the data identifying the transaction data to omit. The digital receipt, which contains *all* of the purchase transaction data, is transmitted by the retail terminal to a storage location for the merchant. The “receiving at a retail terminal input ...that selectively identifies purchase transaction datum for omission” limitation and the “forwarding the personalized digital receipt by the retail terminal over a network” limitations are set forth in independent claim 1. Similar limitations are also presented in the other independent claim 6. Claims 4 and 5 depend from claim 1 and claims 9 and 10 depend from claim 6.

The Examiner relies upon U.S. Patent No. 7,158,948 to Rodriguez et al. (hereinafter “Rodriguez”) and states that Rodriguez discloses “selectively omitting identified purchase transaction data” at col. 4, lines 45-59. Apparently, this statement is based on the sentence in the cited section that reads, “The e-receipt application on the smart card may provide the user with the ability to selectively edit and delete purchase information stored on the smart card.” *Rodriguez*, col. 4, lines 47-50. The e-receipt application refers to a computer program that executes on the smart card to provide safe card functions. *Rodriguez*, col. 4, lines 32-34. The smart card includes input control buttons and an electronic display. The control buttons are used for inputting and selecting specific functions provided by an application operating on the smart card. The electronic display presents information to the user of the smart card that was generated by applications within the smart card. *Rodriguez*, col. 4, lines 26-33.

Putting the teachings of Rodriguez together one arrives at the teaching that the smart card embodiment of the safe card in Rodriguez operates as a handheld computer for its user so the user can display, edit, and delete purchase information stored on the smart card. The electronic receipt or e-receipt is obtained from a merchant terminal during a purchase

transaction. *Rodriguez*, col. 3, lines 28-35. This use of the smart card, however, does not teach or suggest receiving at a retail terminal, which has formatted purchase transaction data into a digital receipt, input from a person at the terminal that is used to omit data from the digital receipt and then forward the resulting personalized digital receipt over a network to a device associated with the person who provided the input at the terminal while also transmitting the digital receipt containing all of the purchase transaction data to a merchant storage location. The smart card of *Rodriguez* does not (1) accept input to identify data to be omitted from a digital receipt at a retail terminal, (2) does not perform receipt editing with a retail terminal, (3) does not forward the edited receipt over a network to a device associated with the person who input the identification data, and (4) does not store a receipt having all of the transaction data in a merchant storage location. The only way in which the Examiner can modify the smart card of *Rodriguez* to perform the method of claim 1 as whole is to use Applicant's specification as a blueprint. Such use, however, is impermissible hindsight.

Those of ordinary skill in the art have not implemented the method of claim 1 on a retail terminal. The reference relied upon by the Examiner does not teach or suggest the modification of a digital receipt at a retail terminal for forwarding of the modified receipt over a network to a user device while also storing the unmodified receipt at a merchant storage location. As discussed in the background section of Applicant's specification, forwarding of a receipt by email is known. What was not known was the modification of the receipt by a person, such as the customer, at the purchase site with the retail terminal before the receipt is sent to a device associated with the person who provided the modification data. *Rodriguez* does not enable modification of the receipt by a person, such as the customer, at the purchase site with the retail terminal before the receipt is sent to a device associated with the person who provided the modification data. Therefore, *Rodriguez* does not address the problem addressed by the invention of claims 1, 5, 6, and 10.

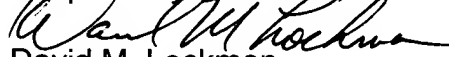
Applicant respectfully submits that the Examiner has not established that Rodriguez teaches "receiving at the retail terminal input from a person at the retail terminal that selectively identifies purchase transaction datum for omission from the digital receipt" and the processing of the digital receipt using that input. All that Rodriguez specifically teaches is that a user may use the input buttons, display, and an e-receipt application on a safe card to retrieve, edit, and store an e-receipt on the card. By requiring that the safe card possess the processing ability to execute the application, the safe card must be implemented with a more expensive smart card, which is also more fragile. *Rodriguez*, col. 4, lines 13-25. The method of claim 1 empowers the retail terminal to provide the functions previously missing without significantly impacting the cost of the terminal and without making its operation more susceptible to environmental conditions. Applicant's specification is the only document of record in this case that enables one of ordinary skill in the art to input at a retail terminal data that selectively identifies transaction data to be removed by the retail terminal from a digital receipt. Examiner's use of Applicant's specification to interpret Rodriguez is impermissible and constitutes clear error. Therefore, the Board should overrule the Examiner on the ground of rejection.

CONCLUSION

The Examiner has failed to present a prima facie case that claims 1, 4-6, 9 and 10 are obvious under 35 U.S.C. § 103(a) and, therefore, unpatentable over Patent Number 7,158,948 to Rodriguez. The Board of Appeals, therefore, is respectfully requested to reverse the rejection of these claims.

August 27, 2007
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Respectfully submitted,



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(8) CLAIMS APPENDIX

1. (Appealed) A method of processing a purchase transaction on a retail terminal, comprising the steps of:

acquiring purchase transaction data with a retail terminal as a result of a purchase transaction being performed on the retail terminal;

formatting the acquired purchase transaction data into a digital receipt with the retail terminal;

receiving at the retail terminal input from a person at the retail terminal that selectively identifies purchase transaction datum for omission from the digital receipt;

selectively omitting the identified purchase transaction datum from the digital receipt to generate a personalized digital receipt;

forwarding the personalized digital receipt by the retail terminal over a network that is in communication with the retail terminal to a device associated with the person who identified the purchase transaction datum for omission from the digital receipt; and

transmitting the digital receipt to a storage location for a merchant.

Claims 2 and 3 (Canceled).

4. (Appealed) The method of claim 1, further comprising the step of:

identifying the device to which the personalized digital receipt is forwarded with data from the purchase transaction data.

5. (Appealed) The method of claim 1, further comprising the step of:

generating a human readable hard copy of the personalized digital receipt at the retail terminal.

6. (Appealed) A method of processing a purchase transaction on a retail terminal, comprising the steps of:

acquiring purchase transaction data with a retail terminal as a result of a purchase transaction being performed on the retail terminal;

generating a digital receipt with the purchase transaction data;

receiving with the retail terminal input from a person at the retail terminal, the received data being used to select purchase transaction datum for omission from the digital receipt;

deleting the selected purchase transaction datum from the digital receipt to generate a personalized digital receipt;

transmitting the personalized digital receipt over a network that is coupled to the retail terminal to a device associated with the person who used the retail terminal to select purchase transaction datum for omission from the digital receipt; and

transmitting the digital receipt to a storage location for a merchant.

Claims 7 and 8 (Canceled)

9. (Appealed) The method of claim 6 further comprising:

identifying the device to which the personalized digital receipt is transmitted with data from the purchase transaction data.

10. (Appealed) The method of claim 6, further comprising the step of:

generating a human readable hard copy of the personalized digital receipt with the retail terminal.

11. (Withdrawn) A system for processing a purchase transaction, comprising:

a retail terminal in communication with a network;

a processing unit within the retail terminal; and

memory within the retail terminal and in communication with said processing unit, said memory storing a plurality of program instructions which, when executed by said processing unit, causes said processing unit to:

a) acquire purchase transaction data on said retail terminal during the purchase transaction;

b) format the acquired purchase transaction data into a digital purchase transaction record;

c) permit omission of selective purchase transaction datum of the acquired purchase transaction data from the digital purchase transaction record by a party to the purchase transaction to create a personalized digital purchase transaction receipt; and

d) transmit the personalized digital purchase transaction receipt over the network to the party to the purchase transaction.

Claims 12 and 13 (Canceled).

14. (Withdrawn) The system of claim 11, wherein the party to the purchase transaction is a consumer who tendered payment during the purchase transaction.

15. (Withdrawn) The system of claim 11, wherein the memory has further program instructions stored therein which, when executed by the processing unit, causes the processing unit to provide a human readable hard copy of the personalized digital purchase transaction receipt to the party to the purchase transaction.

16. (Withdrawn) A system for processing a purchase transaction comprising:

a retail terminal in communication with a network;

a processing unit within said retail terminal; and

memory within said retail terminal and in communication with said processing unit, said memory storing a plurality of program instructions which, when executed by said processing unit, causes said processing unit to:

a) acquire purchase transaction data on said retail terminal in response to the purchase transaction;

b) permit a party to the purchase transaction to omit certain purchase transaction datum of the acquired purchase transaction data to create a modified purchase transaction record;

c) format the modified purchase transaction record into a digital purchase transaction receipt; and

d) transmit the digital purchase transaction receipt over the network to the party to the purchase transaction.

Claims 17 and 18 (Canceled).

19. (Withdrawn) The system of claim 16, wherein the party to the purchase transaction is a consumer who tendered payment during the purchase transaction.

20. (Withdrawn) The system of claim 16, wherein the memory has further program instructions stored therein which, when executed by the processing unit, causes the processing unit to provide a human readable hard copy of the digital purchase transaction receipt to the party to the purchase transaction.

(9) EVIDENCE APPENDIX

No evidence has been submitted in this case and no evidence is being relied upon in this appeal.

(10) RELATED PROCEEDINGS APPENDIX

No other proceedings are related to this application so no materials are provided in this appendix.